

REMARKS

This Amendment And Request For Reconsideration is submitted in response to the Office Action mailed on 03 September 2009 for the above-identified patent application.

In the present Amendment, the Applicants amend claims 8 and 14; no claims have been added or canceled. The Applicants respectfully submit that no new matter has been presented; the amendments are merely corrective in nature and are supported by the application as originally filed. Thus, 1-34, 36-38, and 40-53 as amended are pending in the application for reconsideration.

*In the Office Action mailed on 03 September 2009, the Examiner indicated that claims 18-32 and 44-49 were allowed over the prior art. In response, the Applicants respectfully acknowledge the Examiner's early indication of allowability of these claims, and submit that such claims should be entitled to the appropriate broad scope of coverage as provided under the law.*

*In the same Office Action of 03 September 2009, the Examiner rejected claims 1-17, 33-34, 36-38, 40-43, and 50-53 of the present application under 35 U.S.C. § 103(a) based on what is deemed Applicant's Admitted Prior Art "AAPA" (pages 2-3 of the present application) in view of Bridges et al. (U.S. Patent No. 7,096,015). In response, the Applicants respectfully disagree with these rejections, and submits that these claims are allowable over the prior art of record for at least the following reasons.*

1. The Relied Upon Art Including Bridges Et Al. Fail To Teach Or Suggest A Home Public Land Mobile Network (HPLMN) That Is Prioritized For Selection Over A Registered PLMN (RPLMN) In Response To Regaining Signal Coverage Or Powering On, With The RPLMN Being Second In Priority To The HPLMN.

In order to properly establish rejections under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims. In the present case, the relied upon art fails to teach or suggest each and every limitation of claims 1-17, 33-34, 36-38, 40-43, and 50-53.

Claims 1-17, 33-34, 36-38, 40-43, and 50-53 recite limitations relating to a “mobile station which is associated with a Home Public Land Mobile Network (HPLMN) identified by a home Mobile Network Code (MNC) and Mobile Country Code (MCC) pair” which prioritizes the “selecting and operating with the HPLMN” over “a Registered PLMN (RPLMN)” when “the HPLMN identified by the home MNC/MCC pair is available” in response to regaining signal coverage or powering on. The RPLMN is second in priority to the HPLMN.

In the present case, the relied upon art fails to teach or suggest the selection priority of an HPLMN having a home MNC/MCC pair over an RPLMN in response to the recited conditions, with the RPLMN being second in priority to the HPLMN.

The Examiner’s rejection is based on the combined teachings of the Examiner’s alleged AAPA and Bridges et al. Specifically, the Examiner asserts that “Bridges et al. disclose … [that] the mobile station performs selecting and operating with the home communication network as a first priority if a home communication network of the mobile station is identified as being available.” However, the relied upon art including Bridges et al. do not teach or suggest an HPLMN identifiable by a home MNC/MCC pair *which is prioritized for selection over an RPLMN in response to the recited conditions, with the RPLMN being second in priority to the HPLMN.* The

teachings of Bridges et al. merely focus on systems (e.g. IS-136) that utilize system identification codes (SIDs) and system operator codes (SOCs) – not MNC/MCC pairs as claimed, and not HPLMNs and not RPLMNs as claimed.

On page 2 of the Office Action of 03 September 2009, the Examiner expresses disagreement with the Applicants on such points, stating that the “AAPA already disclose the PLMN identifiable by MCC/MNC pair and HPLMN (see page 2, lines 5-10)” and that “Bridges et al. disclose a home network identifiable by a SID, SOC, or equivalent system identification number of the cellular service provider, is prioritized for selection … (column 12, lines 37-52).” However, the disclosure of the alleged AAPA do not teach or suggest an HPLMN that is first priority over an RPLMN, or an RPLMN that is second priority over the HPLMN. In fact, the alleged AAPA teach just the opposite. Further, the home network identifiable by the SID or SOC in Bridges et al. is not an HPLMN identifiable by a home MCC/MNC pair. Also, there is no RPLMN in Bridges et al.

Importantly, note that the alleged AAPA is derived from standards specifications for PLMN selection. It is important that standards are adhered to when developing technologies. One ordinarily skilled in the art would appreciate the different technology standards (i.e. for network selection) that are adhered to for system technologies. Even Bridges et al. itself acknowledge of the importance of *adherence and compatibility* to standards in column 4 at lines 58-65:

Further, there is a need to provide intelligent roaming capabilities for a mobile station which will not require any changes to present network interface standards (e.g. IS-41) or air interface standards (e.g., IS-136, IS-91A, IS-95). Such features are desirable in order to permit new intelligent roaming capabilities to be readily utilized by a mobile station and to allow seamless integration of such capabilities without modification to present industry standards.

The above passage suggests that Bridges et al. would be sensitive to adherence to communication standards, and not be readily inclined to modify aspects relating to standards.

Thus, it is clear that the relied upon art fail to teach or suggest an HPLMN identifiable by a home MNC/MCC pair which is prioritized over an RPLMN for selection in response to the recited conditions, with the RPLMN being second in priority to the HPLMN.

Based on these reasons alone, the Applicants respectfully request the Examiner to withdraw the rejections and allow claims 1-17, 33-34, 36-38, 40-43, and 50-53.

2. One Ordinarily Skilled In The Art Would Not Have Modified Cellular Telecommunication Standards (e.g. The Alleged "AAPA") With The Teachings Of Bridges Et Al. As Fashioned By The Examiner.

In order to properly establish rejections under 35 U.S.C. § 103(a), there must also be a proper obviousness/non-obviousness assessment that includes some adequate reasoning and/or demonstration that one ordinarily skilled in the art would have combined the teachings of the references to produce that which is claimed.

When considering various prior art teachings for an obviousness/non-obviousness determination under §103,

the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham vs. John Deere Co. of Kansas City*, 383 U.S. 1, pp 17-18 (1966).

In this analysis, a functional approach may be taken which asks whether the improvement of the presented invention is more than a predictable use of prior art elements according to their established functions. It is also helpful and instructive to consider whether there is any teaching, suggestion, or motivation to combine the teachings of the references, either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, in a flexible and non-rigid manner. The reason or evidence of a motivation to combine teachings need not be found explicitly in the prior art references, as one may also "look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, at 1740-41.

The Applicants respectfully submit that one ordinarily skilled in the art would not have been inclined to combine the teachings of the alleged AAPA with Bridges et al. in the manner the Examiner fashions in the rejection of claims 1-17, 33-34, 36-38, 40-43, and 50-53. When making a proper assessment of obviousness/non-obviousness in the present case, which considers *the prior art as a whole* including *long felt but unsolved needs*, and *failure of others*, the techniques of the present disclosure are non-obvious.

The Examiner's rejection is based on the combined teachings of the Examiner's alleged AAPA and Bridges et al. However, the alleged AAPA is actually derived from cellular telecommunications standards, as stated in the application (see e.g. page 2 at lines 31-32 of the present application). It may be said that the standards describe public land mobile network (PLMN) selection techniques from the collective minds of those ordinarily skilled in the art.

The Applicants again submit as Attachment A the 3GPP TS 23.122 V5.3.0 (2003-09), for example, which describes PLMN selection in the 3GPP

context. In section 4.4.3.1 ("At switch-on or recovery from lack of coverage") on page 14 of this standard, it is stated that

4.4.3.1 At switch-on or recovery from lack of coverage

At switch on, or following recovery from lack of coverage, the MS selects the registered PLMN ...

\*\*\*

If there is no registered PLMN, ... the MS follows one of the following two procedures (*i.e.* 4.4.3.1.1 Automatic Network Selection Mode Procedure, and 4.4.3.1.2 Manual Network Selection Mode Procedure) depending on its operating mode...

\*\*\*

4.4.3.1.1 Automatic Network Selection Mode Procedure

The MS selects and attempts registration on other PLMNs, if available and allowable, in the following order:

- i) HPLMN (if not previously selected);
- ii) each PLMN in the "User Controlled PLMN Selector with Access Technology" data field in the SIM (in priority order);
- iii) each PLMN in the "Operator Controlled PLMN Selector with Access Technology" data field in the SIM (in priority order)

Thus, per the standards, after recovering from an out-of-coverage condition, a mobile station operates to select the PLMN with which it had just previously registered (*i.e.* its "RPLMN"). If the RPLMN is unavailable, the mobile station performs a scan to identify and select a PLMN which may be the HPLMN.

However, the specifications do not adequately address the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition, it is specified that the mobile station is limited to selecting the non-home RPLMN (if available) upon recovery. This problem is described on page 19 at lines 26-31 of the present application:

a problem that the specifications do not clearly and specifically address: the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition or after power-on, the standards specify that the mobile station is limited to selecting the non-home RPLMN (if available).

Again, the Examiner's rejection is based on the combined teachings of the Examiner's alleged AAPA and Bridges et al. However, the disclosure of the alleged AAPA do not teach or suggest an HPLMN that is first priority over an RPLMN, or an RPLMN that is second priority over the HPLMN. In fact, the alleged AAPA teach just the opposite. Further, the home network identifiable by the SID or SOC in Bridges et al. is not an HPLMN identifiable by a home MCC/MNC pair. Also, there is no description of any RPLMN in Bridges et al. From the relied upon art, it is unclear how the one ordinarily skilled in the art would make the leap to modify the alleged AAPA to arrive at that which is claimed.

Viewing the alleged AAPA and Bridges et al., one ordinarily skilled in the art would appreciate that the different technologies presented are indeed different and not compatible, as different standards are suitably developed for different technologies. It is important that standards are adhered to in technology development. Operation per standards is ordinarily required to ensure proper operation and compatibility.

In fact, Bridges et al. even acknowledge of the importance of *adherence and compatibility* to standards in column 4 at lines 58-65:

Further, there is a need to provide intelligent roaming capabilities for a mobile station which will not require any changes to present network interface standards (e.g. IS-41) or air interface standards (e.g., IS-136, IS-91A, IS-95). Such features are desirable in order to permit new intelligent roaming capabilities to be readily utilized by a mobile station and to allow seamless integration of such capabilities without modification to present industry standards.

The above passage suggests that Bridges et al. would be sensitive to adherence to communication standards, and not readily modify aspects relating to standards. This is true in the present case.

Considering the above, one ordinarily skilled in the art would not have modified the standards based on the teachings of Bridges et al.

Finally, the Examiner specifically alleges that one ordinarily skilled in the art would have combined these teachings in order "to adapt the teaching of Bridges et al. for selecting the home communication network as a first priority to the network selection method of the AAPA *in order to save cost to the user.*" However, one ordinarily skilled in the art would also have taken into account *other considerations as well*, namely, that while roaming a mobile station will ordinarily not find its HPLMN and therefore a mobile station's step of attempting to find the HPLMN may add an unnecessary and unacceptable processing delay. Therefore, the Examiner's provided rationale is merely one consideration to be taken amongst all of the stated considerations.

Considering the *prior art as a whole*, all considerations, including *long felt but unsolved needs, and failure of others -as evidenced by the long-standing techniques documented in the standards specification for PLMN*

*selection* - the techniques of the present disclosure are clearly non-obvious. The Applicants respectfully request the Examiner to withdraw the rejections of claims 1-17, 33-34, 36-38, 40-43, and 50-53, and allow such claims.

Additional reasons for the further allowability of both the independent and dependent claims 1-17, 33-34, 36-38, 40-43, and 50-53 are apparent to those of ordinary skill in the art, but are not articulated herein due to the reasons already presented above.

As indicated above, the Applicants respectfully acknowledge the Examiner's early indication of allowability of claims 18-32 and 44-49. Further, as the relied upon art fails to teach, suggest, or render obvious claims 1-17, 33-34, 36-38, 40-43, and 50-53, such claims are allowable over the prior art of record. The Applicant respectfully requests reconsideration of the claims 1-17, 33-34, 36-38, 40-43, and 50-53, and allowance of the application, as all statutory requirements have now been met.

Thank you. Please feel free to contact the undersigned if there are any questions or concerns regarding this submission.

Respectfully submitted,

/John J. Oskorep/

Date: 30 October 2009

JOHN J. OSKOREP  
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC  
ONE MAGNIFICENT MILE CENTER  
980 N. MICHIGAN AVENUE, SUITE 1400  
CHICAGO, ILLINOIS 60611 USA

Telephone: (312) 222-1860      Fax: (312) 475-1850